

REMARKS

In the Office Action mailed January 23, 2008, the Examiner rejected claims 21, 23, 25-27 and 29-35. Claim 21 has been amended, claims 23, 25-27 and 29-35 have been cancelled and claim 36 has been added.

REJECTIONS UNDER 35 U.S.C. 112

Claims 21, 23, 25-27 and 29-35 have been rejected under 35 U.S.C. 112 as allegedly being indefinite. Claim 21 has been amended to clarify that the rake boards are just one element of the rake ridge assembly.

REJECTIONS UNDER 35 U.S.C. 103

Claims 21, 23, 25-27 and 29-35 have been rejected under 35 U.S.C. 103 as allegedly being unpatentable over LeBlanc in view of Blubaugh.

Under 35 USC §132, *KSR v. Teleflex*, 82 USPQ2d 1385 and the USPTO Examination Guidelines¹, the Examiner has an obligation to advance reasons in support of rejections under 35 U.S.C. § 103. Applicant requests that the obviousness rejections be reversed because: I) The factual finding made by the Examiner about the teachings of LeBlanc is unsupported by substantial evidence because there is nothing in LeBlanc to suggest that LeBlanc can be modified by complete flattening of the corner piece and subsequent overlapping of the corner piece with the rake boards of a gable roof assembly and thus the Examiner has failed to articulate any reasoning with some rational underpinning to support the legal conclusion of obviousness; II) The Examiner has omitted any factual findings to support aspects of the rejections, because the Examiner has failed to address the fact that the claimed assembly must be part of a gable roof assembly recited in the claim; and III) taking into account any factual findings putatively made, the Examiner has failed to articulate any reasoning with some rational underpinning to support the legal conclusion of obviousness that the corner piece in LeBlanc, would be obvious as applied to the flat, overlapping, gable roof assembly claimed in Applicant's invention.

Claim 21 has been amended to reflect that the rake boards themselves must be part of a gable roof assembly. In the Office Action dated January 23, 2008, on page 4, the examiner considers the phrase "for secure attachment and for defining a joint that is part of a gable roof assembly" to be an intended use. The applicant submits that by requiring the rake boards to be part of a gable roof assembly, this is not merely an intended use and that the

¹ (Federal Register / Vol. 72, No. 195 / Wednesday, October 10, 2007 / Notices pages 57526 through 57535)

assembly itself is not merely a new use for a known product. LeBlanc does not teach the person skilled in the art to modify its teachings to arrive at the claimed combination. Foremost, the structures of LeBlanc are designed to attach two flat, indoor, molding surfaces together via a curved corner piece. The modification of LeBlanc to arrive at the Applicant's claimed invention would defeat the purpose of the LeBlanc corner piece, by requiring that the corner piece be completely flattened. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). See also *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). The corner piece disclosed by LeBlanc cannot be modified to be part of a gable roof assembly without destroying the purpose and function of the corner piece. The corner piece of LeBlanc is curved in nature and requires flush or seamless alignment with the straight segments attached on either end to the corner piece. The corner piece of LeBlanc could therefore not be applied in an overlapping manner to rake boards that are part of a gable roof assembly, as a curved surface cannot be fit to overlap with the rake boards and any overlap requires a non-flush fitting arrangement. It would also be impossible for the edges of the curved corner piece to run parallel with rake boards that are part of a gable roof assembly, as the curvature would not allow for parallel arrangement.

In short, especially as presently amended, the pending claims are believed to patentably distinguish over the prior art of record. Withdrawal of the rejection is therefore respectfully requested.

Further, it is believed improper to engage in a hindsight analysis, attempting to use the present claims as a roadmap to analyze the prior art. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In the case of *In re Rouffet*, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998), the Federal Circuit recognized the risk inherent in such an approach and explained:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability." *Sensorics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of

the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

While it may seem appealing in hindsight to use the basic structure of an indoor trim corner section as part a gable roof assembly, there is simply not enough similarity in the structure, shape, function and material between the two construction applications to allow for simple transfer from one concept to the other. In short, the claimed invention is nonobvious. Withdrawal of the rejection is therefore respectfully requested.

By the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

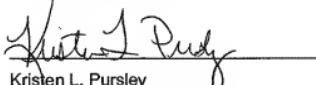
CONCLUSIONS

In view of Applicant's amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicant submits that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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Kristen L. Pursley
Registration No. 61,161
DOBRUSIN & THENNISCH PC
29 W. Lawrence Street
Suite 210
Pontiac, MI 48342
(248) 292-2920

Customer No. 25215